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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,369	06/05/2001	Kengo Ochi	2309/0J434	7467

7590 04/29/2003

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EXAMINER
SMITH, KIMBERLY S

ART UNIT	PAPER NUMBER
3644	

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/875,369	OCHI ET AL.	
	Examiner	Art Unit	
	Kimberly S Smith	3644	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *28 February 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-9*.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Charles T. Jordan

CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because: With consideration to the applicant's response filed 04/11/03: With regards to "alpha-starch" being a trade name, the applicant's submitted an exhibit in the request for reconsideration of Paper #7 which detailed the NIOSH Pocket Guide to Chemical Hazards for the term "Starch". In this guide the term "alpha starch" it is stated under the heading "Synonyms & Trade Names". Without any further clarification to this matter, it was considered that an alpha-starch could either be a synonym or a trade name. It was not asserted that "alpha starch" was in fact a trade name, only the possibility that it could be a trade name until further clarification was presented. Upon the Applicant's assertion that alpha-starch is not a trade name, the Examiner had no basis to disagree with this statement and therefore the term alpha-starch in regards to the Applicant's exhibit has been taken to be synonymous with a starch and not a trade name.

With regards to the Applicant's statement with respect to prior art rejection being overcome at the last paragraph of page 3 in Paper # 12. The contemplation of refiling the application to submit an Official Communication including the information submitted unofficially was considered to be a means for the applicant to introduce material that would be printed on the face of the patent at a time of issue which would include documentation as to what the applicant considers an alpha-starch in an attempt to overcome the 112 1st paragraph rejection. The statement that the art rejection would be overcome was in reference to the Applicant's assertion that the term "alpha-starch" was directed to a pre-gelatinized starch. As the Examiner maintained throughout the prosecution of the case, the term "alpha starch" was not an art recognized term to the degree that the metes and bounds of what the Applicant considered the invention could be ascertained. With official clarification to the specification that the "alpha starch" is defined by the Applicant to be a pre-gelatinized starch, the art rejection of record may not stand. However, this does not preclude that other references may be applicable in the case as the term "pre-gelatinized starch" had not been positively considered. As the specification has not been officially clarified, the term "alpha starch" has been construed to be synonymous with a starch as is consistent with the presented evidence of the Applicant's exhibit in Paper #7.

With regards to the Applicant's statement that ample demonstration that the term "alpha-starch" is used as a generic and art recognized-term as cited in the evidence presented prior to the February 25, 2003 interview. With regards to the 50 of 173 patents that the applicant has stated disclose that "alpha-starch" is a generic term, these 50 references include the term "alpha-starch" as being a "source of carbon" (US 6420145), "a binder" (e.g. US 6417175, US 6384062US 6355672), "a film base not necessarily soluble in water" (US 6416503), "a starch derivative" (e.g. 6392082, 6340702, 6340702), "a cellulose ester" (6375974), "a processed product" (US 6342256), "a thickener" (US 6336935), "a polymer compound having a sugar skeleton" (US 6326332) and note is taken of US 6420145 in which "specific examples of the carbon source include...processed starch, starch derivative, physically processed starch, alpha starch, soluble starch". The US 6420145 patent discloses that an "alpha starch" is considered to be a separate structure from a "physically processed starch" and a "starch derivative" which have been used in cited patents as a definition of "alpha starch". Without clarification to the specification of the instant application, it is maintained that one of skill in the art would not be able to reasonably discern what the term "alpha starch" in the instant application encompasses.

With regards to the Applicant's statement that "The Examiner's response to {over 173 patents had issued that used the term "alpha-starch"} was that she had no control over what other Examiners were doing." And that it was interpreted as a statement to a "prior Examiner's mistake". It is noted that upon mentioning the 173 patents that had issued, the Examiner contended that as she was not the examiner of record in these applications and therefor could not comment on these prior references as to what these references taught or included. It was not a statement regarding prior examiner's "mistake", it was merely a statement directed to the fact that these references had not been submitted as prior art of record and as such, were not germane to the instant application and to whether the disclosure of the instant application was enabling for one in the art to determine the metes and bounds of the term "alpha starch". It is noted that thes previous patents, the term "alpha starch" is included into a list of specific examples as to what the inventor considered to be a generic term thereby providing one with skill in the art to ascertain what the inventor had considered to be equivalent and generic terminology for that application thereby providing an enabling specification. The instant application included no such generic terminology or listing of equivalent terminology.

Regarding applicant's statement with respect to JP 11-032608 (Sasahara) that "According to this reference, a surfactant (a material very different from a starch derivative) may be added to the flat core material". This statement does not reflect upon the rejection of record, as a surfactant was not relied upon as the starch derivative. As such, the response to arguments of the final rejection are applicable..